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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/604,696

06/26/2000

Philip Carragher

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EXAMINER

JOHNSON, GREGORY L

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

01/12/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	09/604,696	CARRAGHER ET AL.	
	Examiner	Art Unit	
	GREGORY JOHNSON	3691	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) 1-29,32-46 and 50-57 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1-29,32-46 and 50-57.

Claim(s) objected to: _____.

Claim(s) rejected: 30,31,47-49 and 58.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art Unit 3691

GREGORY JOHNSON
Examiner, Art Unit: 3691

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments filed December 15, 2010 have been fully considered but they are not persuasive. Applicant's argues (pg. 18) that the Office action is improper for failing to make out a prima facie case of obviousness because the applied references fail to disclose at least one expressly claimed element as follows.

Claim 30:

...associating the card activity reward... with a mortgage interest tax deduction computed for the year... and...generating...output including the crediting of the reward... so as to produce a mortgage interest tax deduction....

On page 18, Applicant recites:

A reward in an amount of several months mortgage payment does not indicate whether the payment would qualify for a mortgage interest tax deduction, e.g. an advance payment on principle would have no interest payment and would have no mortgage interest tax deduction. [Examiner will refer to this as argument (i)]

Even if it did qualify, which Applicant respectfully contests, that does not mean the claimed operations are obvious based on Forward. This particularly follows at least because Forward teaches payments made to a buyer. [Examiner will refer to this as argument (ii)]

Thus, the a mortgage payment by the buyer would just be a vanilla mortgage payment, i.e., the Examiner has not shown why, for buyer mortgage payments, there would be a system doing the crediting, associating, etc. as set out in Applicant's claims. [Examiner will refer to this as argument (iii)]

In response argument (i):

The Examiner disagrees with Applicant's assertion that the teaching of Forward is the same as "an advance payment on principle." As recited in the Office action, Forward discloses in col. 5, lines 20-40 -- (a) Various incentives such as cleaning services, landscaping, pool installation; in addition to "several months mortgage payment." As interpreted, the parties providing these services/mortgage [payment] would be third party(-ies) that Forward refers to in (d) below. Forward discloses in col. 6, lines 4-29 -- (b) Various methods in which a seller/builder of a house could compensate (e.g. commission/fee) the "item locator system" for listing a house for sale. Forward discloses in col. 6, lines 30-41 -- (c) The seller paying the "item locator system" at closing the appropriate commission/fee. At this point, one skilled in the art of finance (i.e. mortgages and loans) would understand that the house has been sold and the buyer now has a mortgage. In addition, one skilled in the art would understand that at closing payment values for both principle and interest are known. Forward discloses in col. 6, lines 42-52 -- (d) The item locator system "executes the incentive" using the appropriate device (e.g. certificate, check, etc.) at the same time as the closing.

As interpreted, the executing of the services/incentives to provide "several months mortgage payments" via an electronic certificate, identification number, check, coupon, or any other device that the buyer may use to execute the incentive indirectly with a third party would be based on the known payment values for both principle and interest. It is very clear to the Examiner that Forward explicitly states "mortgage payments", which are known to include both principle and interest; in addition to the fact that the incentive is executed at the time of closing when values for principle and interest payments are known.

Therefore, the Examiner maintains that the "several months mortgage payments" would have both principle and interest charges and would qualify by law as a mortgage tax deduction.

In response argument (ii):

Forward discloses (col. 6, lines 30-52) that at closing (a) the item locator system is paid at closing by the builder just like the co-broker is now paid at closing and (b) the item locator system provides the incentive execution to the buyer, wherein the incentive execution may comprise an electronic certificate, identification number, check, coupon, or any other device that the buyer may use to execute the incentive indirectly with a third party (e.g. mortgage lender). It is very clear that Forward explicitly recites that the incentive is "several months mortgage payment" and not "several months of advance payment on principle."

In response argument (iii):

Wilcox teaches: associating card activity with a mortgage of a cardholder (column 3, line 60 thru column 4, line 24); determining a reward by calculating a function responsive to the card activity (column 4, line 41 thru column 5, line 55); crediting the reward to the mortgage, said mortgage including interest (column 6, lines 26-39) and generating output including the charge card activity-based mortgage crediting (column 6, lines 26- 39).

Applicant makes similar arguments in regards to claims 31, 47-49 and 58. The same rational used in rejection claim 30 can be applied in rejecting claims 31, 47-49 and 58.